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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/864,694	05/24/2001	Mark Nicholas Johnson	01458	2097

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EXAMINER

HEWITT, JAMES M

ART UNIT

PAPER NUMBER

3679

DATE MAILED: 05/13/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

8K

<b>Office Action Summary</b>	<b>Application No.</b> 09/864,694	<b>Applicant(s)</b> JOHNSON, MARK NICHOLAS	
	<b>Examiner</b> James M Hewitt	<b>Art Unit</b> 3679	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 19 February 2003.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,8-11,14,18 and 19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,8-11,14,18 and 19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                             | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s) _____   |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)         | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Oath/Declaration***

Applicant is required to submit another declaration. The current one is illegible, likely due to it being faxed.

### ***Claim Objections***

Claims 1, 3-6, 8-11, 14 and 18-19 are objected to because of the following informalities:

In claim 1 line 5, it is apparent that "the first or second edges" should be "the first and second edges".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-6, 8-11, 14 and 18-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 line 6, "the aperture" lacks antecedent basis. It is unclear as to how the opening and aperture are related. Are they one and the same? If not, Applicant

should make a clear distinction between the opening and the aperture. To note, claim 4 line 3 also makes reference to the aperture.

In claim 5 line 3, Applicant should relate the recited band of material with that recited in claim 1.

In claim 9 lines 6 and 7, "the opening" lacks antecedent basis. To note, claims 10, 11 and 18 also recite or reference the opening.

In claim 14 line 1 "said former" lacks antecedent basis.

In claim 14 line 2, "said second member" lacks antecedent basis.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9, 10 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Burton et al (US 3,719,389).

With respect to claim 9, Burton et al discloses a method of forming a mechanical joint comprising: taking a first elongated member (39/40), forming an aperture depending from one edge of said member, positioning a member or insert (third mandrel) in the aperture, and moving the first member to move the first and second edges of the opening towards one another to a degree to trap and engage the insert in the opening (see col. 4 line 50-67).

With respect to claim 10, wherein the first and second edges are respectively moved so as to substantially close the opening and hence retain the insert in position in said aperture.

With respect to claim 14, wherein the mandrel (insert) is an insert which is retained in position.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 3-6, 8 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton et al (US 3,719,389) in view of Nicely (US 4,627,543).

With respect to claim 1, Burton et al disclose a mechanical joint for use in the construction of an article, said joint comprising a first member (39/40) for connection with a second member (12), and wherein said first member is provided with an opening for the reception of an insert, the opening defined by first and second edges (see figure 3).

Burton et al differs from the claimed invention by not teaching that the first and second edges of the opening engage the insert. Nicely employing an insert (17) in a corner joint. It would have been obvious to one having ordinary skill in the art at the

time the invention was made to modify Burton et al with the insert of Nicely in order to create a better connection for the joint.

Regarding the limitations requiring the manner in which the joint is formed, i.e. "and, to form the joint, the first or second edges of the opening are moved to engage the insert within the aperture and wherein the opening is formed by removing material from the first member to leave a band of material at said opening", the method of forming the device is not germane to the issue of patentability of the device itself. Therefore, these limitations have been afforded little patentable weight. Refer to MPEP 2113.

The last 3 lines of claim 1 have been interpreted as follows. Burton's opening comprises a thin band of material, and upon modifying Burton by Nicely, the first and second edges of Burton's opening would engage and trap the insert within the opening.

With respect to claim 3, wherein said second member lies in a plane perpendicular to the plane of the longitudinal axis of the first member.

With respect to claim 4, wherein the first member is provided in an initial condition in an elongate form and the movement of the first and second edges of the opening is about a pivotal axis located in the aperture or adjacent thereto so that the first member, when the joint is formed, has relatively angled first and second portion at or adjacent to the formed joint.

With respect to claim 5, wherein the opening is formed so as to extend from one side of the member to the opposite side leaving a band of material at the opposite side.

With respect to claim 6, wherein an insert (17) is provided in said opening and has upper and lower collars which protrude respectively above or below the first member.

With respect to claim 8, wherein said second member is attached to an insert held within said opening.

With respect to claim 19, wherein a forming means (third mandrel; see col. 4 lines 50-67) is provided initially in the opening and is subsequently moved out of the opening and replaced by the insert which is held in position in the opening in the first member to form the mechanical joint.

Claims 11 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Burton et al (US 3,719,389) in view of Cruson (US 3,103,742).

Burton et al teach all the limitations except that the opening is closed by a closing member (weld material). In Figures 1 and 2 Cruson disclose welding the opening of the tubular member closed. It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify Burton et al by closing the opening as taught by Cruson in order to permanently seal the tubular member.

### ***Response to Arguments***

Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. Refer to the above rejections.

In response to applicant's argument that there is no suggestion to combine Burton and Cruson, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). Cruson teaches welding a tubular member (7) about another tubular member (1) to form a permanent joint. And from Cruson, the Examiner considers it obvious to one having ordinary skill in the art at the time the invention was made to modify Burton to weld tubular portion (39) to tubular portion (40) to close the opening therebetween in order to create a permanent joint.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any



Application/Control Number: 09/864,694  
Art Unit: 3679

Page 8

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

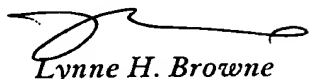
Any inquiry concerning this communication or earlier communications from the examiner should be directed to James M Hewitt whose telephone number is 703-305-0552. The examiner can normally be reached on M-F, 930am-600pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

jmh

May 6, 2003

  
*Lynne H. Browne*  
*Supervisory Patent Examiner*  
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